

REMARKS

Claims 11 to 20 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph three (3) of the Office Action, Applicants thank the Examiner for acknowledging the claim for foreign priority, and for indicating that all certified copies of the priority documents have been received.

With respect to paragraph eight (8) of the Office Action, claims 13, 15, 17, and 18 were rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

While the rejections may not be agreed with, to facilitate matters, claims 13, 15, 17, and 18 have been rewritten to clarify the claimed subject matter, as suggested by the Office Action. It is respectfully submitted that the claims, as presented, now better comply with the definiteness requirement of the second paragraph of 35 U.S.C. § 112.

Approval and entry are respectfully requested, as is withdrawal of the indefiniteness rejections.

With respect to paragraph ten (10) of the Office Action, claims 11 to 13, 16, 17, and 19 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,215,450 (the Oka reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law

make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 11 relates to a window-integrated antenna for a vehicle, including a heating conductor field, which is provided for FM reception and LMS reception, and *at least one decoupling element for the FM reception which has a high-frequency, low-resistance, and non-galvanic connection to the heating conductor field.*

The Oka reference does not identically disclose (or even suggest) the feature of at least one decoupling element for the FM reception, as provided for in the context of claim 11. In contrast, the Oka reference merely refers to an AM/FM antenna pattern and one or more AM antenna patterns which are synthesized by superimposing the received voltages. (Oka, col. 2, lines 24 to 28; and col. 3, lines 20 to 38). Nowhere does the Oka reference refer to *at least one decoupling element for the FM reception*. Further, nowhere does the Oka reference indicate that the at least one decoupling element for the FM reception has *a high-frequency, low-resistance, and non-galvanic connection* to the heating conductor field. Therefore, the Oka reference does not identically disclose (or even suggest) all of the features of claim 11.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 12, 13, 16, 17, and 19 depend from claim 11 and are therefore allowable for at least the same reasons as claim 11.

Accordingly, it is respectfully submitted that claims 11 to 13, 16, 17, and 19 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph eleven (11) of the Office Action, claims 11, 14, 15, and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,201,506 (the Endo reference).

Claim 11 relates to a window-integrated antenna for a vehicle, including a heating conductor field, which is provided for FM reception and LMS reception, and *at least one decoupling element for the FM reception which has a high-frequency, low-resistance, and non-galvanic connection to the heating conductor field.*

The Endo reference does not identically disclose (or even suggest) the feature of at least one decoupling element for the FM reception which has a high-frequency, low-resistance, and non-galvanic connection to the heating conductor field, as provided for in the context of claim 11. In contrast, the Endo reference merely refers to a driven antenna which is mutually coupled to one side of the defogger. (Endo, col. 2, lines 12 to 15; and col. 3, lines

57 to 65). Nowhere does the Endo reference indicate that the at least one decoupling element for the FM reception has a *high-frequency, low-resistance, and non-galvanic connection* to the heating conductor field. Therefore, the Endo reference does not identically disclose (or even suggest) all of the features of claim 11.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 14, 15, and 20 depend from claim 11 and are therefore allowable for at least the same reasons as claim 11.

Accordingly, it is respectfully submitted that claims 11, 14, 15, and 20 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph thirteen (13) of the Office Action, claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Oka reference, in view of U.S. Patent No. 5,933,118 (the Kakizawa reference).

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As more fully set forth above, the Oka reference does not disclose (or even suggest) all of the features of claim 11. Claim 18 depends from claim 11 and is therefore allowable for essentially the same reasons provided above, since the Kakizawa reference does not cure - and is not asserted to cure - the critical deficiencies of the Oka reference.

Further, there is no suggestion or motivation to combine the Oka reference and Kakizawa reference. The Oka reference refers to synthesizing multiple received voltages from several AM antenna in order to increase the receiving sensitivity. In contrast, the Kakizawa reference refers to switching between different received voltages. Combining the Oka reference with the Kakizawa reference would defeat the intended purpose of the Oka

reference of increasing the receiving sensitivity. Therefore, it is respectfully submitted that there is no suggestion or motivation to combine the Oka and Kakizawa references.

Withdrawal of the rejection of the claim is therefore respectfully requested.

In sum, claims 11 to 20 are allowable.

Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

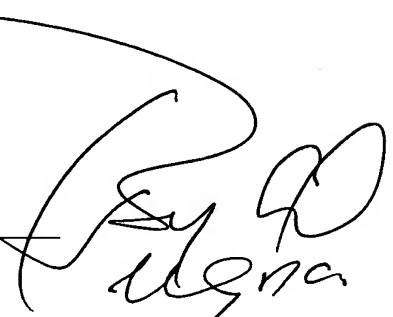
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